

OCT 25 2002

TECHNOLOGY CENTER R3700

EV07996181SUS

PATENTS
HEH/002

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Hilicki et al.
Application No. : 09/606,426
Confirmation No. : 6100
Filed : June 28, 2000
For : COIN DISPLAYING BOOK
Group Art Unit : 3772
Examiner : Mark T Henderson

10/23/2002 SSESHE1 00000050 09606426 320.00 DP
01 FC:1402 920.00 DP
02 FC:1253

Hon. Commissioner for Patents
P.O. Box 2327
Arlington, VA 22202

New York, New York 10020
October 17, 2002

APPLICANTS'/APPELLANTS' APPEAL
BRIEF UNDER 37 C.F.R. § 1.192

Sir:

Pursuant to 37 C.F.R. § 1.192, applicants/appellants file this Appeal Brief, in triplicate, in support of their June 10, 2002 Notice of Appeal from the Examiner's final Office Action of April 18, 2002.

Pursuant to 37 C.F.R. § 1.136(a), applicant hereby petitions for a three-month extension of time for response to the Notice of Appeal. With this extension, the due date for Reply to this Office Action is November 10, 2002.

Pursuant to 37 C.F.R. § 1.17(c), applicants/appellants enclose herewith a check in the amount of \$320.00

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in payment of the filing fee for this Appeal Brief. The Commissioner is authorized to charge any additional fees that may be due, or to credit any overpayment, in connection with the filing of this Appeal Brief, to Deposit Account No. 06-1075. A separate Authorization to Charge Deposit Account is enclosed for that purpose (in duplicate).

In view of the arguments and authorities set forth below, this Board should find the rejection of claims 1-6, 8, 10-33, 35, 37, 39-58, 60, 61, 63, and 65-68 of this application, which have now been twice rejected in their present form, to be in error and should reverse it. Claims 1-6, 8, 10-33, 35, 37, 39-58, 60, 61, 63, and 65-68 are patentable.

This Brief has the following appendices:

Appendix A: Copy of an example of a Sacagawea coin display book constructed in accordance with the principles of applicants'/appellants' invention, wherein:

- Page 1 illustrates the exterior front cover with two coin receivable apertures and with images printed inside the coin receivable apertures;
- Page 2 illustrates the interior front cover;
- Pages 3-28 illustrate the plurality of pages that form the book and contain preprinted information;
- Page 29 illustrates the interior rear cover;
- Page 30 illustrates the exterior rear cover; and
- Page 31 illustrates two caps that are insertable into the coin receivable apertures of the exterior front cover.

- Appendix B: Copy of ISBN 0-439-20822
(hereinafter 'ISBN'), wherein:
Page 1 illustrates the exterior front
cover of the protective folder;
Pages 2-3 illustrates the interior covers
of the protective folder attached to
a plastic layer with coin receivable
apertures;
Page 4 illustrates the exterior rear cover
of the protective folder.
Pages 5-38 illustrates the pamphlet that
comes with ISBN; and
Page 39 illustrates the two sides of the
removable band that packages the
pamphlet to the folder.
- Appendix C: Copy of the final Office Action dated
April 18, 2002; and
- Appendix D: Copy of claims 1-6, 8, 10-33, 35, 37, 39-
58, 60, 61, 63, and 65-68 involved in this
Appeal.

I. IDENTIFICATION OF REAL PARTY-IN-INTEREST

Pursuant to 37 C.F.R. § 1.192(c)(1), applicants/
appellants respectfully advise the Board that the real
party-in-interest in the above-identified patent application
is Treat Entertainment Inc., a corporation organized and
existing under the laws of the State of Alabama, and having an
office and place of business at 3101 Clairmont Road, Suite C,
Atlanta, Georgia, 30329, which is the assignee of this
application.

II. RELATED APPEALS AND INTERFERENCES

Pursuant to 37 C.F.R. § 1.192(c)(2), applicants/
appellants respectfully advise the Board that there are no
other appeals or interferences known to them, their legal
representative, or their assignee, which will directly affect

or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Claims 1-6, 8, 10-33, 35, 37, 39-58, 60, 61, 63, and 65-68 are pending in this application and are on appeal. Claims 7, 9, 34, 36, 38, 59, 62, and 64 were cancelled during prosecution of this application, and thus are not the subject of this Appeal.

IV. STATUS OF AMENDMENTS

Applicants/appellants have not submitted any amendment pursuant to 37 C.F.R. § 1.116 or in reply to the Examiner's April 18, 2002 final Office Action, from which this Appeal is being sought.

V. SUMMARY OF THE INVENTION

Applicants/appellants' invention, which is variously defined by the pending claims on appeal as a coin display book (claims 1-6, 8, 10-33, 35, 37, and 39-43) and method for making a coin display book (claims 44-58, 60, 61, 63, and 65-68.) The book according to the invention having a cover, the exterior of the cover that defines one or more coin receivable apertures.

In known protective coin folders, coin-receivable apertures are located on the folder's interior. Thus, if a user desires to remove, add, or view a coin then that user

must first open the folder and locate the relevant coin or coin-receivable aperture. In such a system, coins are collected in the interior of the folder so that they are kept safe from potentially dangerous elements. There is no ability to view the coins after the folder is closed; once the folder is closed, the coins cannot be viewed and the folder loses the functionality of an active coin display.

According to applicants/appellants' invention, on the other hand, coin-receivable apertures are defined in the exterior of a book. Therefore, a user can add, remove, and view coins from the exterior of the book. Put another way, the structure of the book, as claimed, provides the ability to view and manipulate coins placed in applicants'/appellants' exterior coin-receivable apertures when the book is closed. The structure of previously known folders does not provide this utility or functionality.

When combined with the other elements, as claimed, of applicants'/appellants' invention, the book's display qualities are enhanced even more. Specifically, the invention does not focus only on storing coins, but focuses on describing the book's theme through the use of a plurality of attached sheets (e.g., pages) containing pre-printed information (e.g., a story). The Board has been provided with an example of applicants'/appellants' invention, the Sacagawea book of Exhibit D, in order to show how the structure of the invention contributes to the invention's functionality.

VI. ISSUES ON APPEAL

Generally, the issue that is to be reviewed on this appeal is whether or not applicants/appellants' invention as defined by claims 1-6, 8, 10-33, 35, 37, 39-58, 60, 61, 63, and 65-68 are obvious in view of ISBN 0-439-20822 (hereinafter "ISBN".) Specifically, the issue is whether or not ISBN, which discusses a coin display book with an internal aperture, makes the claimed invention -- i.e., a coin display book with an aperture defined in the exterior of one of the covers -- obvious.

VII. GROUPING OF CLAIMS

The issues identified above relate to a single ground of rejection of the application on appeal. However, all the claims on appeal, claims 1-6, 8, 10-33, 35, 37, 39-58, 60, 61, 63, and 65-68, stand or fall together with respect to the issue presented above (Rejection A). If the first ground of rejection falls, then independent claims 1 and 44 are patentable and the rejections of those claims dependent upon independent claims 1 and 44 would fall because the claims would be dependent from a patentable claim.

VIII. ARGUMENT

The first ground of rejection of claims 1-6, 8, 10-33, 35, 37, 40-58, 60, 61, 63, and 65-68 on appeal is a rejection under 35 U.S.C. § 103(a) based on ISBN.

Introduction

Before describing the merits of the claimed invention, and in order to aid the Appeal Board in visualizing an exterior coin-receivable aperture, applicants/appellants direct the attention of the board to page 1 of Exhibit A. This page illustrates the first book cover in the exterior of which two coin receivable apertures are defined. It should be noted that the book theme is present inside each coin receivable aperture in the form of a life-size image of one side of a Sacagawea dollar.

A. The Invention is Not Obvious From ISBN

The Examiner alleges that ISBN discusses "a book comprising a first book cover (A) and a second book cover (B) wherein the second book cover defines coin receivable apertures (C) in the interior side of one of the covers (FIG. 1) for receiving caps (coin)" (Examiner's Final Action, Page 3). Furthermore, the Examiner alleges that

"it would have been obvious to one having ordinary skill in the art at the time the invention was made to place the apertures at any desirable location on the cover, since it has been held that rearranging parts of an invention involves only routine skill in the art *In re Japikse*, 86 USPQ 70. By placing the apertures on the exterior side of the cover, the cover is only further being used as a display device by enhancing its marketability. [emphasis in original] The 'the operation of the device (display book) would not be modified' since shifting of the apertures from the interior to the exterior only enhances the display" (Examiner's Action, Page 6).

In regards to claims 1 and 44, applicants'/appellants' invention claims a coin displaying book with at least one or more coin receivable apertures defined in the exterior of at least one of its covers. As a result, coins may be viewed, inserted, removed, and manipulated in these exterior apertures even after the book is closed.

ISBN does not discuss coin-receivable apertures that are defined in the exterior of at least one of the covers. ISBN only discusses, at best, placing coin receivable apertures on the interior of the covers. In fact, ISBN does not discuss defining apertures in at least one of the covers, as suggested by the Examiner. Instead, ISBN teaches a transparent piece of plastic that is attached to the cover's interior. The coin receivable apertures are defined in this transparent piece of plastic; the piece of plastic being a separate layer that is attached the covers.

Because ISBN does not have exterior coin-receivable apertures it follows that when ISBN is closed, the apertures may not be displayed and coins may not subsequently be viewed, inserted, removed, or manipulated. For these reasons, the prior art pertains more specifically to a way of storing coins in order to protect them, not actively displaying coins, as claimed by applicants'/appellants' invention, on the exterior of a book's cover in order to give the book a coin storing

functionality, while increasing the whimsical and festive nature of the book.

Furthermore, while *In re Japikse*, 86 USPQ 70 (1950) states that there is no invention in shifting a component to a different position only if "the operation of the device would not thereby be modified" (*Id.* at 73), applicants/appellants have shown above that the operation of a folder or book would be modified if the coin receivable apertures were moved from the interior of a cover to the exterior of one. Specifically, applicant/appellants' coin display book does not have to be opened in order to add, remove, or manipulate coins as required by ISBN. As a result, the functional operation of applicants'/appellants' invention is different from ISBN.

The Examiner commented that "it would have been obvious to one having ordinary skill in the art at the time the invention was made to place the aperture at any desirable location on the cover (whether it is inside or outside the cover), since it has been held that rearranging parts of an invention involves only routine skill in the art" (*In re Japikse*, 86 USPQ 70 (1950)). However, it is well settled that the mere fact that the prior art could be modified would not have made the modification obvious unless the prior art suggested the desirability of the modification: *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

With respect to the field of the present invention, coin collecting devices have been around for hundreds of years and have been developed in order to protect and preserve valuable coins from the effects of weather, time, dust, and light. As a result, a majority of the prior art involves encasing the coins in order to preserve and protect coins. One of the more common devices used to encase coins has been a coin collecting folder, in which the coins are stored in coin-receivable apertures located inside the folder and protected only after the book is closed.

Applicants' claimed invention is different from these prior art coin collecting folders because it is a book (such as a story book) that contains coin-receivable apertures located on a book cover's exterior; applicants'/appellants' invention is a coin displaying book. In shifting the apertures to the exterior of the book, the operation of the coin display book is different from that of the prior art; applicants'/appellants' invention does not have to be opened to view, add, remove, or manipulate coins. The prior art protects -- the invention displays.

Applicants/appellants respectfully submit that the Examiner may have overlooked a critical element from the *In re Japikse* holding. Specifically, the Examiner states that "rearranging parts of an invention involves only routine skill in the art." This cited quote is misleading because it was

not made by the Appeal Board, but by the Primary Examiner during prosecution of the case. Particularly, the Primary Examiner in *In re Japikse* states that "the relocation of Cannon's switch A-42 so that it may be operated by beaver tale 62 instead of by dog A-2 is devoid of invention" (*In re Japikse*, 86 USPQ 74).

The Appeal Board, however, held that "there would be no invention in shifting the starting switch disclosed by Cannon to a different position since the operation of the device would not thereby be modified" (*In re Japikse*, 86 USPQ 73). For this reason, the Appeal Board holds that if the operation of a device is modified by shifting one or more of its components, then a unique and novel invention would exist.

According to the principles of *In re Japikse*, if the operation of a coin book changes as a result of a shifting of these coin receivable apertures then a unique and novel invention would exist. Moving the apertures to the exterior of the cover eliminates the need for opening the book in order to view, add, remove, and manipulate the coins. Thus, this claimed element distinguishes the operation of applicants' coin display book from the prior art. The coins may be seen without opening the coin book and may provide insight into the theme of the pre-printed information of the book.

This modification is not obvious because the prior art does not suggest the desirability of the modification. *In*

re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Because ISBN only contains interior coin-receivable apertures and is silent on any modification to them thereof, ISBN does not show or suggest the desirability of having exterior coin receivable apertures.

Furthermore, ISBN also teaches away from including exterior coin-receivable apertures. ISBN teaches away from including exterior coin-receivable apertures because ISBN teaches including a removable pamphlet in the book. As a result, a user can remove the pamphlet and read about the coins while keeping the folder closed in order to protect the coins. By implication, this teaches that, although the coins may not be accessible when the folder is closed, certain information -- i.e., the pamphlet information -- may still be accessible by, for example, removing the pamphlet. However, when the folder is closed, the user is never able to view the coins.

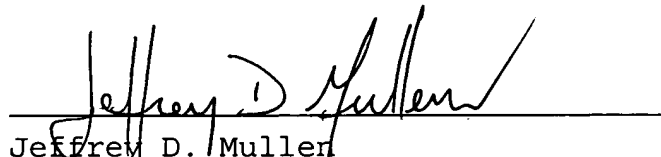
For at least the above reasons, independent claims 1 and 44, and any claims dependent thereof, are allowable because applicants'/appellants' claimed invention is a book that has a theme and is capable of displaying one or more coins related to the theme that includes the structure of an exterior coin-receivable aperture. ISBN does not show or suggest a book that has a theme and is capable of displaying one or more coins related to the theme that includes the

structure of an exterior coin-receivable. By including exterior coin-receivable apertures in the book, applicants'/appellants' coin display book advantageously allows a user to view, add, remove, and manipulate a coin without forcing that user to open the book. Thus, applicants'/appellants' coin display book overcomes a disadvantage present in ISBN because ISBN only discusses interior coin-receivable apertures.

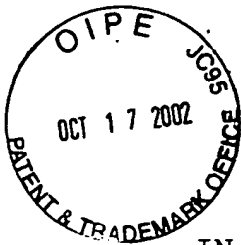
IX. CONCLUSION

For the reasons set forth above, applicants/appellants respectfully submit that this application is in condition for allowance. The Examiner's rejections should be reversed.

Respectfully submitted,

A handwritten signature in black ink, reading "Jeffrey D. Mullen", is written over a horizontal line.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Hilicki et al.
Application No. : 09/606,426 Confirmation No.: 6100
Filed : June 28, 2000
For : COIN DISPLAYING BOOK
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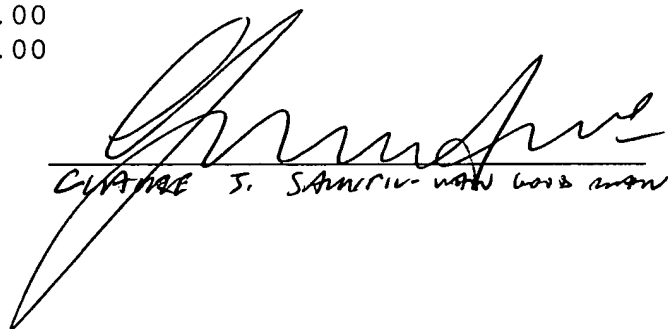
EXPRESS MAIL CERTIFICATION

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Date of Deposit October 17, 2002

I hereby certify that the papers and fees identified below are being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. § 1.10 on the date indicated above and are addressed to the Commissioner for Patents, P.O. Box 2327, Arlington, Virginia 22202, Box AF.

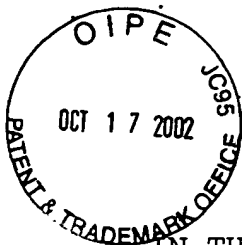
Transmittal Letter (in duplicate)
Appeal Brief (in triplicate)
Authorization to Charge Deposit Account (in duplicate)
Check in the amount of \$920.00
Check in the amount of \$320.00


CHARLES S. SAMUELS - with box & man

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New York, New York 10020
October 17, 2002

TRANSMITTAL LETTER

Sir:

Transmitted herewith: [X] Appeal Brief (in triplicate);
[] Request For Oral Hearing Pursuant to 37 C.F.R. § 1.194 (in
duplicate); [X] Authorization to Charge Deposit Account (in
duplicate); to be filed in the above-identified patent
application.

FEE FOR ADDITIONAL CLAIMS

[X] A fee for additional claims is not required.

[] A fee for additional claims is required.

[] A check in the amount of \$_____ in payment of the
filing fee is transmitted herewith.

[] Please charge \$_____ to Deposit Account No. 06-1075
in payment of the filing fee. A duplicate copy of this
transmittal letter is transmitted herewith.

[X] The Director is hereby authorized to charge payment of any
additional filing fees required under 37 C.F.R. § 1.16, in

connection with the paper(s) transmitted herewith, or credit any overpayment of same, to deposit Account No. 06-1075. A duplicate copy of this transmittal letter is transmitted herewith.

EXTENSION FEE

[X] The following extension is applicable to the Appeal Brief filed herewith; [] \$110.00 extension fee for response within first month pursuant to 37 C.F.R. § 1.17(a)(1); [] \$400.00 extension fee for response within second month pursuant to 37 C.F.R. § 1.17(a)(2); [X] \$920.00 extension fee for response within third month pursuant to 37 C.F.R. § 1.17(a)(3); [] \$1440.00 extension fee for response within fourth month pursuant to 37 C.F.R. § 1.17(a)(4).

[X] A check in the amount of [] \$110.00; [] \$400.00; [X] \$920.00; [] \$1440.00; in payment of the extension fee is transmitted herewith.

[X] The Director is hereby authorized to charge payment of any additional fees required under 37 C.F.R. § 1.17 in connection with the paper(s) transmitted herewith, or to credit any overpayment of same, to Deposit Account No. 06-1075. A duplicate copy of this transmittal letter is transmitted herewith.

[] Please charge the [] \$110.00; [] \$400.00; [] \$920.00; [] \$1440.00; extension fee to Deposit Account No. 06-1075. A duplicate copy of this transmittal letter is transmitted herewith.

FEE FOR FILING APPEAL BRIEF

[X] A check in the amount of \$320.00 in payment of the fee for filing the appeal brief is transmitted herewith.

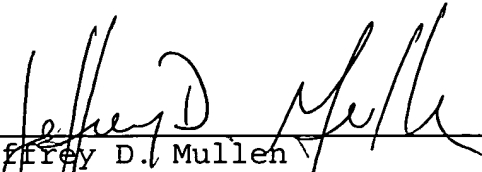
[X] The Director is hereby authorized to charge payment of any additional extension fees required under 37 C.F.R. § 1.17 in connection with the papers transmitted herewith, or credit any overpayment of same, to Deposit Account No. 06-1075. A duplicate copy of this transmittal letter is transmitted herewith.



FEE FOR FILING REQUEST FOR ORAL HEARING

- [] A check in the amount of \$280.00 in payment of the fee for filing the Request For Oral Hearing is transmitted herewith.
- [X] The Director is hereby authorized to charge payment of any additional extension fees required under 37 C.F.R. § 1.17 in connection with the papers transmitted herewith, or credit any overpayment of same, to Deposit Account No. 06-1075. A duplicate copy of this transmittal letter is transmitted herewith.

Respectfully submitted,



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AUTHORIZATION TO CHARGE DEPOSIT ACCOUNT

Sir:

The Director is hereby authorized to charge any additional fee due, or credit any overpayment, in connection with the accompanying Applicants'/Appellants' Appeal Brief Under 37 C.F.R. § 1.192, to Deposit Account No. 06-1075. A duplicate copy of this Authorization is enclosed herewith.

Respectfully submitted,

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